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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,557	02/28/2002	Samuel W. Ho	57243-5007	5091
24574	7590	03/13/2006	EXAMINER	
JEFFER, MANGELS, BUTLER & MARMARO, LLP 1900 AVENUE OF THE STARS, 7TH FLOOR LOS ANGELES, CA 90067			LE, LINH GIANG	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/086,557	<b>Applicant(s)</b> HO, SAMUEL W.	
	<b>Examiner</b> Linh-Giang Le	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>022802</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Notice to Applicant***

1. The communication is in response to the application filed 28 February 2002.

Claims 1-30 are pending.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claim 1 is rejected because it is directed to nonfunctional descriptive material and is not statutory. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed is not statutory. Applicant merely describes a tool that lists one or more entities and a measure of frequency. This is a mere compilation of data but does not create any functional interrelationship between the stored data nor the computer process performed by the computer.

5. Claims 2-9 are dependent on claim 1 and the reasons for rejection are incorporated herein.

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6. Claim 10 is directed to nonfunctional descriptive material and is not statutory and is rejected for the same reasons as claim 1. Claims 11-8 are dependent on claim 10 and the reasons for rejection are incorporated herein.

7. Claims 19-22 are directed to nonfunctional descriptive material and are not statutory and are rejected for the same reasons as claim 1.

8. Claims 23-25 are directed to nonfunctional descriptive material and are not statutory and are rejected for the same reasons as claim 1.

9. Claim 26 is directed to nonfunctional descriptive material and is not statutory and is rejected for the same reasons as claim 1.

10. Claim 27 is directed to nonfunctional descriptive material and is not statutory and is rejected for the same reasons as claim 1.

11. Claim 28 is directed to nonfunctional descriptive material and is not statutory and is rejected for the same reasons as claim 1.

12. Claim 29 is directed to nonfunctional descriptive material and is not statutory and is rejected for the same reasons as claim 1.

13. Claim 30 is directed to nonfunctional descriptive material and is not statutory and is rejected for the same reasons as claim 1.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood (5,706,441) in view of Pack-Harris (6,195,612).

16. As per claim 1, Lockwood teaches a quality rating tool wherein the quality rating tool is used to select an entity for providing health care services to a health care consumer (Lockwood; Abstract).

Lockwood does not expressly teach a measure indicating the frequency with which a level of dosing of a medication was prescribed by an entity. However, this feature is well known in the art as evidenced by Pack-Harris. In particular, Pack-Harris teaches a system enabled to monitor prescription utilization information (Pack-Harris; Col. 2, lines 39-45). Examiner interprets the level of dosing of a medication as part of prescription utilization information. It would have been obvious to add the prescription utilization feature of Pack-Harris to the Lockwood quality-rating tool with the motivation of providing information regarding the drugs obtained and their actual costs (Pack-Harris; Col. 2, lines 18-22).

17. As per claim 2, Lockwood teaches a quality rating tool (Lockwood; Abstract) but fails to expressly teach a tool wherein the medication includes painkillers. This feature is well known in the art as evidenced by Pack-Harris for the same reasons as cited in claim 1.

18. As per claim 3, Lockwood teaches a quality rating tool (Lockwood; Abstract) but fails to expressly teach a tool wherein the measure is derived from a number of prescriptions in which a predetermined amount by weight of painkillers is not exceeded. This feature is well known in the art as evidenced by Pack-Harris for the same reasons as cited in claim 1.

19. As per claim 4, Lockwood teaches a quality rating tool (Lockwood; Abstract) but fails to expressly teach a tool wherein the predetermined dosage is four grams and the painkiller is acetaminophen (APAP). This feature is well known in the art as evidenced by Pack-Harris for the same reasons as cited in claim 1. Examiner further notes one of ordinary skill in the art would know this predetermined dosage to accurately monitor prescription utilization information.

20. As per claim 5, Lockwood teaches a quality rating tool (Lockwood; Abstract) but fails to expressly teach a tool wherein the level of dosing indicated is a safe level dosing. This feature is well known in the art as evidenced by Pack-Harris for the same reasons as cited in claim 1.

21. As per claim 6, Lockwood teaches a quality rating tool wherein the entity is a medical group (Lockwood; Col. 4, lines 35-39). Examiner interprets "group of health care providers" to be a "medical group."

22. As per claim 7, Lockwood teaches a quality rating tool wherein an entity is a hospital (Lockwood; Col. 4, lines 35-39). Examiner interprets "group of health care providers" to be a "hospital."

23. As per claim 8, Lockwood teaches a quality rating tool wherein the measure is categorized in a clinical measures category (Lockwood; Col. 11, lines 20-23).

24. As per claim 9, Lockwood teaches a quality rating tool wherein the measure is further categorized in a patient safety category (Lockwood; Col. 4, lines 46-52). Examiner interprets "sickness episode data records" to include patient safety information.

25. As per claim 10, Lockwood teaches a quality rating tool (Lockwood; Abstract) comprising:

A listing of one or more entities, an entity being a type of health care provider (Lockwood; Col. 4, lines 35-39); and

Lockwood fails to expressly teach a measure indicating the frequency with which use of an antibiotic for treating a condition is prescribed by an entity, wherein the quality rating tool is used to select an entity for providing health care services for a health care consumer. However, this feature is well known in the art as evidenced by Pack-Harris. In particular, Pack-Harris teaches a system enabled to monitor prescription utilization

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information (Pack-Harris; Col. 2, lines 39-45). It would have been obvious to add the prescription utilization feature of Pack-Harris to the Lockwood quality-rating tool with the motivation of providing information regarding the drugs obtained and their actual costs (Pack-Harris; Col. 2, lines 18-22).

26. As per claim 11, Lockwood does not expressly teach a quality rating tool wherein the measure is an indication of a number of prescribed antibiotics where the prescribed antibiotics are medically accepted for initiating treatment of a condition. However, this feature is well known in the art as evidenced by Pack-Harris. In particular, Pack-Harris teaches a system enabled to monitor prescription utilization information (Pack-Harris; Col. 2, lines 39-45). One of ordinary skill in the art could interpret the medically accepted number of antibiotics as part of the prescription utilization information. It would have been obvious to add the prescription utilization feature of Pack-Harris to the Lockwood quality-rating tool with the motivation of providing information regarding the drugs obtained and their actual costs (Pack-Harris; Col. 2, lines 18-22).

27. As per claim 12, Lockwood teaches a quality rating tool wherein the condition includes bronchitis (Lockwood; Col. 4 lines 46-52). Examiner interprets bronchitis to be one of a plurality of sickness episodes.

28. As per claim 13, Lockwood does not expressly teach a quality rating tool wherein the measure is derived from a number of preferred antibiotic prescriptions and a number



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of total antibiotic prescriptions for treating the condition. This feature is well known in the art as evidenced by Pack-Harris for the same reasons as cited in claim 10.

29. Claim 14 repeats the limitations of claim 6 and the reasons for rejection are incorporated herein.

30. Claim 15 repeats the limitations of claim 7 and the reasons for rejection are incorporated herein.

31. As per claim 16, Lockwood teaches a quality rating tool wherein the measure is represented in the quality rating tool as a percentile ranking (Lockwood; Col. 12, lines 40-44).

32. Claim 17 repeats the limitations of claim 8 and the reasons for rejection are incorporated herein.

33. Claim 18 repeats the limitations of claim 9 and the reasons for rejection are incorporated herein.

34. As per claim 19, Lockwood does not expressly teach a measure indicating the frequency with which appropriate diagnostic testing was performed when prescribing antibiotics for a condition, wherein the quality rating tool is used to select an entity for

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providing health care services to a health care consumer. Lockwood does teach a tool that contains a data record corresponding to a sickness episode for which health care services were performed (Col. 5, lines 61-64). The frequency with which a diagnostic testing was performed would be information in a data record corresponding to a sickness episode.

35. Claim 20 repeats the limitations of claim 11 and the reasons for rejection are incorporated herein.

36. Claim 21 repeats the limitations of claim 13 and the reasons for rejection are incorporated herein.

37. Claim 22 repeats the limitations of claim 12 and the reasons for rejection are incorporated herein.

38. As per claim 23, Lockwood teaches a quality rating tool comprising:

A listing of one or more entities, an entity being a type of health care provider;  
and

A measure indicating the cost of health services and products incurred by a health care consumer obtaining health care services from an entity, wherein the quality rating tool is used to select an entity for providing health care services (Lockwood; Col. 11, lines 27-29).

39. As per claim 24, Lockwood does not expressly teach a quality rating tool wherein a measure indicating the cost of health services and products incurred by a health care consumer includes a measure indicating pharmaceutical costs incurred by a health care consumer. However, this is well known in the art as evidence by Pack-Harris. In particular, Pack-Harris teaches analyzing drug costs (Pack-Harris; Col. 2, lines 28-33). It would have been obvious to add the cost analysis feature of Pack-Harris to the Lockwood tool with the motivation of providing information regarding drugs obtained (Pack-Harris; Col. 2, lines 18-22).

40. As per claim 25, Lockwood teaches a quality rating tool wherein a measure indicating the cost of health services and products incurred by a health care consumer includes a measure indicating emergency medical costs incurred by a health care consumer (Col. 6, lines 38-43). Examiner interprets "emergency medical costs" to be in patient claims records relating to a health care service.

41. Claim 26 repeats the limitations of claims 5, 10 and 18 and the reasons for rejection are incorporated herein. Examiner interprets "overuse of antibiotics" as a "patient safety category."

42. Claim 27 repeats the limitations of claims 24 and 25 and the reasons for rejection are incorporated herein.

43. As per claim 28, Lockwood teaches collecting data from a plurality of sources relating to a plurality of measures used in the quality rating tool (Lockwood; Col. 5, lines 57-61). The other features of claim 28 repeat limitations of claims 1 and 5 and the reasons for rejection are incorporated herein.

44. Claim 29 repeats the limitations of claims 28 and 10 and the reasons for rejection are incorporated herein.

45. Claim 30 repeats the limitations of claim 26 and 28 and the reasons for rejection are incorporated herein.

### ***Conclusion***

46. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a health data processing system (5,778,345); a method and system for generating statistically-based medical provider utilization profiles (5,557,514); and an analyses and report of performance of service providers (5,652,842).

47. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Linh-Giang Le whose telephone number is 571-272-8207. The examiner can normally be reached on 8:30 AM - 5PM, M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
LLe

  
C. LUKE GILLIGAN  
PATENT EXAMINER